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09/636,108	08/10/2000	Erik M. Theisen	GLNPIN114873	6358

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EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/636,108

Applicant(s)

THEISEN ET AL.

Examiner

Ming Chow

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6,8-10,15,16,22,24-26,31 and 32 is/are allowed.
- 6) ☒ Claim(s) 1-5,7,11-14,17-21,23,27-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Reopening of Prosecution After Appeal***

1. In view of the appeal brief filed on 1-20-04, PROSECUTION IS HEREBY REOPENED.

New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Allowable Subject Matter***

2. Claims 6, 8-10, 15-16, 22, 24-26, 31-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Regarding claims 6, 22, the prior art does not teach, on a cordless telephone, a vibratory supervisory signal is sent from the base unit

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to the handset. Regarding claims 8, 24, the prior art does not teach, on a cordless telephone, a supervisory signal operates at variable intervals on the handset. Regarding claims 15, 31, the prior art does not teach stopping the repositioning at the beginning of the message and playing a message envelop before playing the message from the beginning.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5, 7, 11, 12, 14, 17-19, 21, 23, 27, 28, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertocci (US: 5953656), and in view of AT&T Answering System 1721 Owner's Manual and further in view of Chamberlin (US: 4309571).

Regarding claims 1, 17, Bertocci teaches on Fig. 1 and Fig. 2 a portable handset and a base unit with TAD (the TAD of Bertocci reads on the claimed VMS) circuits.

Bertocci teaches on column 10 line 32-42 the TAD control functions, including playing message, can be entered from the keypad of the handset (Note: Bertocci's handset is a cordless telephone which reads on the claimed telephone). It is inherent that the keypad generates a "start" command to activate the "play message" feature.

Bertocci fails to explicitly teach a "stop" command is generated from the handset for stopping the "play message" feature. However, using telephone keypad to generate control signal

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for remotely stopping the playing feature of an answering machine was old and well known feature. The Owner's Manual of AT&T Answering System 1721 teaches that a remote caller can press "#" from his telephone to stop the message playback of the remote answering machine (see page 13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Bertocci such that the handset user can generate a "stop" command from the handset to stop the message playback in the base unit. The modification frees the handset user to hear the entire message.

Bertocci further fails to teach "providing feedback to the user via a supervisory signal during repositioning". In other words, Bertocci does not teach that a display is used to show the progress of repositioning during playing of a message in the base unit. However, Chamberlin teaches on column 4 line 12-40 a telephone answering device and/or dictation unit with index, or cursor indication, or LED, or LCD to indicate the repositioning. Chamberlin further teaches a display (unit 24, Fig. 1) has cursor for indicating the movement of the tape when the tape is advanced from one end toward the other. Since using indicator to indicate the position of a message or a tape is very old and well known and such indicator was widely used in "playback" feature, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Bertocci as modified by the AT&T Owner's Manual above and further to have a display as taught by Chamberlin in the base unit of Bertocci such that the user of Bertocci can know how far the message has been announced during the "playback" of a message. Such modification further provides additional information to the user to realize how much memory space has been used.

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Regarding claims 2, 18, Bertocci teaches that the TAD commands for “playing message” are entered via the keypad.

Regarding claims 3 & 19, the modified Bertocci as stated in the rejections for claim 1 & 17 above inherently has the claimed keyed “stop” command (see page 13, “#” of AT&T Answering System 1721 Owner’s Manual).

Regarding claims 5, 21, the modified Bertocci as stated in the rejections for claims 1 & 17 above inherently has the claimed limitation because the LCD, LED or the cursor (see col. 4 lines 25-28 of Chamberlin) are the claimed visual signal.

Regarding claims 14, 30, the modified system of Bertocci in view of AT&T Answering System 1721 Owner’s Manual, and Chamberlin as stated in claim 1 above failed to teach “the repositioning comprises rewinding”. However, this feature is very old and common. See page 13, left column, the “2” command teaches the “rewinding” feature. Thus, it would be obvious to further modify Bertocci to allow the handset user to remote activate the rewinding feature of the base unit. The modification gives additional control feature, i.e., remote control to the handset user such that the user does not need to always next to the TAD.

Regarding claim 7 & 23, Chamberlin displays the indicator by LED and LCD during the whole (fix) interval of playback.

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Regarding claims 11 & 27, "fast forward". See page 13, the skip message command.

Regarding claims 12 & 28, the Manual teaches the "skip" control command which is obvious to provide in the handset of Bertocci for freeing the user to hear the entire message.

4. Claims 4, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertocci (US: 5953656), and in view of AT&T Answering System 1721 Owner's Manual, and Chamberlin, and further in view of Rosen et al (US: 5784436).

Bertocci in view of AT&T Answering System 1721 Owner's Manual and Chamberlin as stated in claim 1 above failed to teach "the supervisory signal is an aural signal". However, Rosen et al teach on column 1 line 22-24 a warning beep (claimed "aural signal") to indicate the conversation is being recorded.

It would have been obvious to one skilled at the time the invention was made to modify Bertocci, AT&T Answering System 1721 Owner's Manual, Chamberlin to have aural signals as taught by Rosen et al such that the modified system of Bertocci, AT&T Answering System 1721 Owner's Manual, Chamberlin would be able to comply with the law to inform the other party of the call that the conversation is being recorded.

5. Claims 13, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertocci (US: 5953656), and in view of AT&T Answering System 1721 Owner's Manual, Chamberlin, Ireton (US: 5970447).

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Bertocci in view of AT&T Answering System 1721 Owner's Manual, Chamberlin, as stated in claims 12 and 28 above failed to teach "providing a signal that the end of the message has been reached". However, the end of message signal were very old in the art of telephone answering machine. For example Ireton teaches on column 1 line 21-23 that the end of message signal is used to enable the TAD to detect the end of message. Thus, it would have been obvious to one skilled at the time the invention was made to modify Bertocci, AT&T Answering System 1721 Owner's Manual, Chamberlin, and further modify Bertocci's TAD to generate the end of message signal as taught by Ireton such that the TAD of Bertocci can immediately detect the end of the message such that the TAD can stop the playback feature – a way to prevent overload the TAD.

6. Claims 1 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilcox et al (US: 6404856), and in view of Greco et al (US: 5568540).

Wilcox teaches a telephone (see Fig. 2 and col. 4 line 9-11) with a voice message system (see Fig. 1, 3 and col. 3 line 41-42, col. 5 line 65 – col. 6 line 6). Wilcox teaches that an audio bar (col. 2 line 62) is used to show the progress of an incoming message during a recording mode (col. 4 line 35-42). Wilcox further teaches that the recorded message can be retrieved for playback (col. 6 line 31-53) by using the telephone (Note, the start/stop playback commands are generated by pressing the buttons on Fig. 3 which is on the telephone as shown in Fig. 2). What Wilcox fails to show is that the audio bar is used to show the position of a recorded message during the message is in playback mode. However, Greco at Fig. 3 shows that an audio time line bar is used as a progress indicator during a message playback mode (col. 5 line 50-55). Further,



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the benefit of using the timeline bar is obvious. The person who hears the message knows how long is the message such that he may terminate a long message. Therefore, it would be obvious to modify Wilcox such that when a message is being announced, the audio bar as taught by Greco will be used to show the "repositioning" information.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Todd (US: 4645875) teaches telephone answering programming devices.

8. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**Or faxed to Central FAX Number 703-872-9306.**

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Patent Examiner

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Ming Chow



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